Supreme Court, U.S.
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No. 08-445

IN THE

Supreme Court of the United States

FINISAR CORPORATION,

Petitioner,

v.

THE DIRECTV GROUP, INC., DIRECTV HOLDINGS LLC, DIRECTV ENTERPRISES LLC, DIRECTV OPERATIONS LLC, HUGHES NETWORK SYSTEMS, INC., AND DIRECTV, INC.,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF IN OPPOSITION

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QUESTION PRESENTED

Under 35 U.S.C. § 112, ¶ 6, a patented device or system may be claimed as containing one or more components defined in terms of their function instead of their structure, but only if the patent's specification describes in sufficient detail a structure designed to perform the claimed function. Unless this requirement of § 112, ¶ 6 is met, the claim violates the rule that patent claims must "particularly point[] out and distinctly claim[]" the invention. 35 U.S.C. § 112, ¶ 2.

The patent at issue in this case, which describes an information broadcasting system that gives subscribers access to information via high-speed satellite or cable links, claims the system as containing a means "for generating a hierarchically arranged set of indices for referencing data in said information database, including distinct indices for referencing distinct portions thereof, and for embedding said indices in said information database." The patent specification merely repeats the claimed generating-and-embedding function and states that this claimed function will be performed by a general-purpose computer with "software," without providing any description of the software or how the computer should be programmed to perform the claimed function. The question presented by these facts is whether these particular patent claims violate § 112, ¶ 6's requirement that the specification sufficiently describe a structure for performing the claimed function.

CORPORATE DISCLOSURE STATEMENT

Liberty Media Corporation owns more than ten percent of The DIRECTV Group, Inc. stock. No entities other than the named respondents own ten percent or more of the stock of any respondent.

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BRIEF IN OPPOSITION

Respondents The DIRECTV Group, Inc., DIRECTV Holdings LLC, DIRECTV Enterprises LLC, DIRECTV Operations LLC, Hughes Network Systems, Inc., and DIRECTV, Inc. respectfully request that the Court deny Finisar Corporation's ("Finisar") petition for a writ of certiorari for four basic and fundamental reasons:

First, the decision below, a factbound application of longstanding law, was correct.

Second, the petition demonstrates no conflict. Rather, the Court of Appeals' decision is consistent with prior precedent.

Third, although Finisar's petition seeks to have the petition in another case (*Aristocrat Technologies Australia Pty Ltd. v. International Game Technology*, No. 08-446 (U.S. filed Oct. 3, 2008)) granted, and Finisar's own petition held, the principal argument made by the petitioner in that other case was waived there, and Finisar itself never raised that argument in this case. As a result, the courts below in both cases never considered that argument, which makes it inadvisable for this Court to take up the issue without the benefit of prior adversarial treatment and decision.

Fourth, this case is a poor vehicle for resolving any question relating to the patent claims at issue, in view of ongoing proceedings in the district court and in the U.S. Patent and Trademark Office ("PTO").

In short, Finisar has presented no compelling reason for certiorari.

REASONS FOR DENYING THE WRIT

I. The Court Of Appeals' Decision Was Correct

The Federal Circuit's decision in this case, which applied longstanding law to the claim language of a particular patent, was correct. The patent at issue, U.S. Letters Patent No. 5,404,505 ("the '505 patent"), describes an information broadcasting system that allows subscribers to access information via high-speed satellite or cable links. Seven system claims (claims 1, 2, 7, 9, 10, 11, and 37) in the '505 patent contain a "means-plus-function" clause claiming a means "for generating a hierarchically arranged set of indices for referencing data in said information database, including distinct indices for referencing distinct portions thereof, and for embedding said indices in said information database." Because the claims contain such a "means-plus-function" clause, 35 U.S.C. § 112, ¶ 6 applies. That provision requires the patent's specification to describe in sufficient detail the structure designed to perform the claimed function. (The specification is the portion of the patent that both precedes and includes the claims. 35 U.S.C. § 112, ¶¶ 1-2.) Applying § 112, ¶ 6, the Court of Appeals affirmed the district court's judgment and held that the '505 patent specification, which refers only to implementation of the claimed function on an undefined "computer" with undefined "software," does not provide sufficient structure and therefore the claims are invalid for indefiniteness. The court's decision was correct.

Section 112, ¶ 6 was included in the 1952 Patent Act as a response to the Court's decision in 1946 holding it improper to claim a device, system, or other thing in terms of its function (what the

invention does) rather than in terms of its structure (what it is). *See Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946). In *Halliburton*, the Court reasoned that such functional claiming renders a patent claim indefinite because it fails to adequately define the alleged invention to warrant the protection of a patent. *See id.* at 13. As the Court explained, a patent awarded for a device or system claimed in terms of a function rather than a structure would extend the patent's exclusionary force to any and all later inventions of devices or systems that perform that function—improperly allowing a patent applicant to "obtain greater coverage by failing to describe his invention than by describing it as the statute commands." *Id.* at 12-13.

The inclusion of the means-plus-function provision in the Patent Act of 1952 overruled *Halliburton* by allowing functional claiming of devices or systems, but it did not overlook this Court's objection in *Halliburton* to broad functional claiming. *See* 35 U.S.C. § 112, ¶ 6. Thus, § 112, ¶ 6 permits a patent applicant to claim a device or system as containing one or more components in terms of their function, but only if the specification adequately describes the structure intended to perform the claimed function. *Id.* (requiring "corresponding structure, material, or acts" to be set forth in the specification). In other words, the patent's specification must elaborate on what structure is contemplated to perform the claimed function so that the patent does not occupy more of the field of art than what has truly been invented. If the specification discloses sufficient structure, the claim is "construed to cover" that structure "and equivalents thereof," thereby transforming the functional words used in the claim

into a structural definition of the patented invention. *Id.*

In essence, the structure requirement of § 112, ¶ 6 strikes a bargain with patent applicants who want to use the means-plus-function format to describe their inventions. *See Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 27-28 (1997). To enjoy the convenience of functional claiming, and to benefit from the fact that the claim will be construed to cover the specification's description of structure and equivalents of that structure, the patent applicant must adhere to his or her end of the bargain by describing sufficient defining structure in the specification. *See* 35 U.S.C. § 112, ¶ 6; *In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed. Cir. 1994) (en banc) ("[I]f one employs means-plus-function language [per § 112, ¶ 6] in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language.").

In paragraph 2 of § 112, the Patent Act sets forth a definiteness requirement, which applies to all types of patent claims, including means-plus-function claims. Under this requirement, a claim must "particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, ¶ 2. Otherwise, the claim is invalid. The structure requirement of § 112, ¶ 6 effectuates the definiteness requirement of § 112, ¶ 2. *See In re Donaldson*, 16 F.3d at 1195; *In re Lundberg*, 244 F.2d 543, 547 (C.C.P.A. 1957). For a means-plus-function claim, therefore, "[i]f an applicant fails to set forth an adequate disclosure [pursuant to the structure requirement of § 112, ¶ 6], the applicant has in effect failed to particularly point

out and distinctly claim the invention as required by the second paragraph of section 112." *In re Donaldson*, 16 F.3d at 1195; *id.* (explaining that the structure "show[s] what is meant" by the claim).

The definiteness requirement, and its embodiment in paragraph six's structure requirement, play an important role in patent law—one noted in *Halliburton*. *See* 329 U.S. at 10. In light of a patent holder's right to exclude, which is an "exception to the general rule against monopolies," competitors and other members of the public have "a paramount interest" in requiring precise claiming to keep patents "within their legitimate scope." *Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 816 (1945). The structure requirement carries out this public interest in clearly defined claims. *See Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1220 (Fed. Cir. 2003) ("The public should not be required to guess as to the structure for which the patentee enjoys the right to exclude.").

In the particular factual context of this case—involving a set of computer-implemented means-plus-function claims—the Court of Appeals correctly held that "the patent must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm to provide the necessary structure under § 112, ¶ 6." (Pet. App. 36a.) This holding follows well-established precedent. *See Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008) ("In cases involving a computer-implemented invention in which the inventor has invoked means-plus-function claiming, this court has consistently required that the

structure disclosed in the specification be more than simply a general purpose computer or microprocessor."); *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1253 (Fed. Cir. 2005) ("A computer-implemented means-plus-function term is limited to the corresponding structure disclosed in the specification and equivalents thereof, and the corresponding structure is the algorithm."); *Tehrani v. Hamilton Med., Inc.*, 331 F.3d 1355, 1362 (Fed. Cir. 2003) ("[T]he structure corresponding to the processing function is the disclosed microprocessor that is programmed to perform the disclosed algorithm."); *Creo Prods. v. Presstek, Inc.*, 305 F.3d 1337, 1345 (Fed. Cir. 2002) ("[A] computer-implemented means-plus-function claim is limited to a computer programmed to perform the algorithm disclosed in the specification."); *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999) ("In a means-plus-function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.").

Some sort of algorithm is required to provide definiteness for a computer-implemented means-plus-function claim because, absent an algorithm, "a general-purpose digital computer [is] but a storeroom of parts and/or electrical components." *In re Prater*, 415 F.2d 1393, 1403 n.29 (C.C.P.A. 1969); *WMS Gaming*, 184 F.3d at 1348 & n.3 (a general-purpose computer "contains a myriad of interconnected transistors that operate as electronic switches" and the algorithm causes those switches to operate in a particular way); *see generally Gottschalk v. Benson*,

409 U.S. 63, 65 (1972) ("The general-purpose computer is designed to perform operations under many different programs."). Without more, the computer remains an undefined "black box," lacking sufficient defining structure to satisfy § 112, ¶ 6. *See* Pet. App. 37a; *see also Aristocrat*, 521 F.3d at 1333; *WMS Gaming*, 184 F.3d at 1348.

Nothing magical, formal, or burdensome is involved in disclosing an algorithm; the requirement is "not . . . a lofty standard." (Pet. App. 37a.) Rather, only "enough of an algorithm" to provide sufficient definition of structure is required. (Pet. App. 36a.) As the Court of Appeals observed, the applicant may "express that algorithm in any understandable terms including as a mathematical formula, in prose, or as a flow chart, or in *any other manner that provides sufficient structure*." *Id.* (emphasis added); *see also Med. Instrumentation*, 344 F.3d at 1214 (dispensing with the need to disclose "the specific program code"); *In re Dossel*, 115 F.3d 942, 946-47 (Fed. Cir. 1997) (holding that disclosure of an exact mathematical algorithm is not required); *In re Noll*, 545 F.2d 141, 149 (C.C.P.A. 1976) (holding that there is no need to disclose "the detailed internal structure of the computer as programmed"). The point is that an algorithm is what provides structure to the general-purpose computer, transforming it from an undefined means that can do virtually anything to the definite structure of a computer with a particular purpose (*i.e.*, a special-purpose computer); this, in turn, provides the public with notice of the bounds of the patent's exclusionary rights.

Finisar contends that the Court of Appeals' ruling overlooks that one skilled in the art may know how to

implement an algorithm for a given function. (*See* Pet. 19-20.) In making this argument, Finisar improperly conflates the "enablement" requirement of § 112, ¶ 1 with the definiteness requirement of § 112, ¶¶ 2 and 6. Under the enablement requirement, an applicant must provide enough details in the patent specification to make it possible for a skilled worker to make and use the claimed device. *See* 35 U.S.C. § 112, ¶ 1 (requiring the specification to "contain a written description . . . as to enable any person skilled in the art to which it pertains . . . to make and use the same"). In contrast, the definiteness requirement compels the applicant to particularly point out and distinctly define the structure of the invention claimed, either within the claim itself or (where paragraph 6 is invoked) within the part of the specification linked to that claim. The definiteness requirement ensures that "one of skill in the art would understand the *specification itself* to disclose a structure, not simply [that] that person would be capable of implementing a structure." *Biomedino, LLC v. Waters Techs. Corp.*, 490 F.3d 946, 953 (Fed. Cir. 2007) (emphasis added). Where the specification discloses only a "computer" without any further elaboration, such as a described algorithm for programming the computer, the public cannot possibly know what is being claimed by the patentee with the powerful right to exclude.

The seven computer-implemented means-plus-function claims at issue here failed this basic test. It is undisputed that the '505 patent specification simply mentions a "CPU" (*i.e.*, a central processing unit or general-purpose computer, *see* Pet. 6) having "software" and fails to disclose any algorithm under which that computer operates. The Court of Appeals

correctly held that, without any algorithm (let alone "enough of" one, Pet. App. 36a), the claims are invalid for indefiniteness.

Each claim at issue includes a means-plus-function clause that requires a "database editing means" for performing the function of "generating a . . . set of indices" and "embedding [those] indices in [the] information database." ('505 Patent at 17:68-18:9; *see* Pet. App. 35a.) The means-plus-function clause in independent claim 1 is representative:

> database editing means, coupled to said one or more computer memory devices, for generating a hierarchically arranged set of indices for referencing data in said information database, including distinct indices for referencing distinct portions thereof, and for embedding said indices in said information database.

('505 Patent at 17:68-18:9; *see* Pet. App. 35a.) Dependent claims 2, 7, 9, 10, and 11 contain the same limitation, and the means-plus-function limitation in independent claim 37 is also identical, except that it omits "hierarchically arranged." ('505 Patent at 29:56-64; *see* Pet. App. 35a.)

Rather than provide structural substance to the functional limitation of "database editing means," the specification merely repeats the claimed function. The sole passage in the specification that corresponds to the claimed function is this: "software 132 (executed by CPU 130) generates a hierarchical set of indices referencing all the data in the information database 112 and embeds those indices in the information database." ('505 Patent at 6:37-40; *see* Pet. App. 35a-36a, 50a.) As a side-by-side comparison shows, other than mentioning that a

general-purpose computer with "software" of unspecified characteristics will implement the function, the specification merely restates the function recited in the claims:

Claim Language ('505 Patent at 18:3-9)	Specification ('505 Patent at 6:36-40)
database editing means, coupled to said one or more computer memory devices, for generating a hierarchically arranged set of indices for referencing data in said information database, including distinct indices for referencing distinct portions thereof, and for embedding said indices in said information database;	More specifically, software 132 (executed by CPU 130) generates a hierarchical set of indices referencing all the data in the information database 112 and embeds those indices in the information database.

The mere repetition of the generating-and-embedding function, performed on an undefined general-purpose computer with undefined "software," does not disclose to the public what was ostensibly invented and covered by the claim. (Pet. App. 36a.) Regarding the specification's reference to a computer, given that the "database editing means" must be "coupled to . . . one or more computer memory devices," it is difficult to imagine that anything *but* a computer of some sort could possibly provide that "database editing means." And the specification's reference to undefined "software 132" does not provide any additional meaning. The specification

provides no description whatsoever of how the software generates and embeds the indices. Indeed, from the summary-judgment record below, it is not even clear that software accomplishing the generating-and-embedding function *could* actually be built. *See* Declaration of Expert Witness Dr. Martin Rinard at 2-3, *Finisar Corp. v. DIRECTV Group, Inc.*, No. 1:05-cv-0264, Docket No. 39, Ex. 9 (E.D. Tex. Dec. 19, 2005) (noting "fundamental and currently unsolved problems in computerized information organization and understanding" pursuant to which he "would not know how to build" the necessary "software"). As the Court of Appeals explained, "[s]imply reciting 'software' without providing some detail about the means to accomplish the function is not enough." (Pet. App. 36a-37a.) The specification lacks sufficient structure.

In short, by "provid[ing] nothing more than a restatement of the function, as recited in the claim," the patent "does not even meet the minimal disclosure necessary to make the claims definite." (Pet. App. 36a.) The Court of Appeals correctly affirmed the district court's judgment that the claims are invalid for indefiniteness.

II. The Court Of Appeals' Decision Is Consistent With Prior Precedent, And Any Alleged Differences In The Cases Are Grounded In Their Facts

Finisar challenges the Court of Appeals' decision as creating an intra-circuit conflict. (Pet. 11-20.) The argument is without merit. For one, intra-circuit conflicts are usually "deemed an intramural matter to be resolved by the Court of Appeals itself," and not an appropriate matter for this Court's certiorari

review. John M. Harlan, *Manning the Dikes*, 13 Rec. N.Y.C. B. Ass'n 541, 552 (1958); *cf. Davis v. United States*, 417 U.S. 333, 340 (1974). For another, no conflict actually exists. In issuing a unanimous panel decision and summarily denying rehearing *en banc* without even requesting a response, the Court of Appeals adhered to long-established law on definiteness and means-plus-function claiming in general, and to computer-implemented means-plus-function claims in particular. *See supra* at pp. 2-7.

The alleged differences in circuit precedent are nothing more than different results on differing facts. *See In re Dossel*, 115 F.3d at 946-47 (basing conclusion that means-plus-function claims were definite on "the specific facts in this case"). Because an algorithm is not a magical, formal, or "lofty" requirement (Pet. App. 37a), a fact-intensive inquiry determines whether "enough of an algorithm" is disclosed in the specification to give structure and satisfy § 112, ¶ 6. Pet. App. 36a; *accord Med. Instrumentation*, 344 F.3d at 1214; *In re Dossel*, 115 F.3d at 946-47; *In re Noll*, 545 F.2d at 149-50. The facts of each case control the outcome—in some of the cases cited by Finisar, some sort of algorithm *was* disclosed; in others, the decision turned on issues other than the adequacy of an algorithm. *See Aristocrat Techs. Austl. Pty Ltd. v. Multimedia Games, Inc.*, 266 F. App'x 942, 947-48 (Fed. Cir. 2008) (disclosure of a "pseudo-random number generating algorithm" could be sufficient if the particular steps "are readily apparent to a person of skill in the art or are disclosed in the specification"); *Med. Instrumentation*, 344 F.3d at 1211 (addressing the separate question whether the specification "clearly links or associates software" with the claimed

function); *In re Dossel*, 115 F.3d at 946-47 (addressing the separate question whether the *computer* was adequately disclosed; there was no issue concerning an algorithm because the specification disclosed particular steps that the device would perform, including steps for data inputs, computation, and data outputs); *In re Noll*, 545 F.2d at 149-50 (disclosure of a "specified programmed" computer was sufficient); *CIVIX-DDI, LLC v. Microsoft Corp.*, 84 F. Supp. 2d 1132, 1147 (D. Colo. 2000) (sufficient disclosure because the specification "discloses the functions of" software step-by-step).

Finisar's attempt to manufacture a conflict between decisions involving computer-implemented technology and those in other areas of technology (*see* Pet. 14-17) is without basis. Regardless of the technology, the same legal requirements have been applied: sufficient structure must be disclosed to define the claim. That inquiry depends on the specific factual circumstances of each case. For example, a functional claim limitation linked to a "selector" has been found to comply with § 112, ¶ 6 because a selector has well-known structure, inherently limiting (and thus defining) that term. *See S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1370 (Fed. Cir. 2001) (noting that a selector "is a standard electronic component whose structure is well known in this art" and has "standard components [that] are usually represented in the manner shown in the [patent-in-suit]"); *see also Intel Corp. v. VIA Techs., Inc.*, 319 F.3d 1357, 1360, 1365-66 (Fed. Cir. 2003) (disclosure of a "core logic of a computer adapted to perform Fast Write" and "the protocol used to perform Fast Write" was sufficient structure for more general functions of "writ[ing] data" and

"determin[ing] whether data is able to be written" (emphasis omitted)). Unlike that disclosed "selector," a general-purpose computer, mentioned without any description of its particular programming, has no well-known structure. *See WMS Gaming*, 184 F.3d at 1403 n.3 (explaining that the internal structure of a computer changes when programmed by different software instructions); *In re Prater*, 415 F.2d at 1394 n.29 (noting that a general purpose computer is just "a storeroom of parts and/or electrical components"). For a "computer" to have sufficient structure, enough of an algorithm must be disclosed to define that general term.

The various factual differences among the Court of Appeals' decisions do not warrant this Court's review. Indeed, when certiorari review of one such factual scenario was recently sought, the Court denied the writ and, prior to making that decision, did not even request a response. *See Biomedino, LLC v. Waters Techs. Corp.*, 128 S. Ct. 653 (2007) (mem.). Finisar's factbound petition, too, should be denied.

III. Finisar Has Waived The Principal Argument In The *Aristocrat* Petition, And In Any Event The Arguments In That Petition Are Without Merit

Finisar does not appear to seek plenary review, but instead refers to the arguments made in a concurrently filed petition that presents a similar question. *See* Petition for a Writ of Certiorari, *Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.*, No. 08-446. Indeed, Finisar would prefer that this Court grant the *Aristocrat* petition and then later dispose of Finisar's petition in light of a decision in *Aristocrat*. (Pet. 11, 22.)

Finisar's reliance on the *Aristocrat* petition is misplaced. The crux of that petition is the argument that an algorithm is not required for means-plus-function claims because means-plus-function claims are product claims that can only be satisfied by disclosure of "structure" or "material," not "acts," and an algorithm is not structure (or material). (Pet. in No. 08-446, at 16-21.) Finisar never made that argument in this case, and so it is waived for review here. (Indeed, for the reasons set forth by respondents in the Brief in Opposition in No. 08-446, the petitioner there also waived the argument by failing to offer it in the lower courts.) Because the argument appears for the first time in this Court, without the benefit of adversarial presentation or decision in the Court of Appeals or in either district court in the two cases, it would be inappropriate for this Court to "review" it either in this case or in No. 08-446. *See United States v. United Foods, Inc.*, 533 U.S. 405, 416-17 (2001) ("The Government's failure to raise its argument in the Court of Appeals deprived respondent of the ability to address significant matters that might have been difficult points for the Government."); *Youakim v. Miller*, 425 U.S. 231, 234 (1976) (per curiam) ("Ordinarily, this Court does not decide questions not raised or resolved in the lower court."). Moreover, if the petitioners are correct in their assertions that the validity of computer-implemented means-plus-function claims is not an uncommon issue (Pet. 20-21; Pet. in No. 08-446, at 28), then there should be ample opportunities to await a more appropriate case, one in which that argument was properly joined prior to its arrival here.

In any event, the argument is fatally flawed. For all of the *Aristocrat* petition's efforts seeking to contrast product claims with process claims, and "structure" and "material" with "acts," the argument hinges on the claim that an algorithm can never provide structure because an algorithm is an act, not a thing. (Pet. in No. 08-446, at 16-21.) An algorithm, however, in the context of a general-purpose computer, results in the structural definition of a thing—a special-purpose computer.

The other arguments in the *Aristocrat* petition, some of which overlap with Finisar's, are equally without merit for the reasons stated above and in the respondents' Brief in Opposition to that petition.

IV. Ongoing Proceedings Render This Case A Poor Vehicle For This Court's Review

Even setting aside the correctness of the Court of Appeals' decision, and its faithfulness to established law, the petition should be denied because of ongoing proceedings that may moot any determination by this Court.

First, the case stands in an interlocutory posture. In the judgment sought to be reviewed, the Court of Appeals remanded the case for a new trial, and the remanded proceedings are pending. This in itself is sufficient reason to deny the petition. *See, e.g., Va. Military Inst. v. United States*, 508 U.S. 946, 946 (1993) (Scalia, J., on denial of petition) (mem.); *Bhd. of Locomotive Firemen v. Bangor & Aroostook R.R.*, 389 U.S. 327, 328 (1967) (per curiam). Moreover, the proceedings on remand could moot any determination by this Court because, although the system claims at issue here are not directly involved in the remanded proceedings that concern method claims, the two sets

of claims are effectively identical—the patent similarly claims "systems and methods for scheduling transmission of database tiers upon specific demand or at specific times and rates of repetition." (Pet. App. 3a; *see also* Pet. 6-7.) For instance, both sets require an "information database" in which the information is "referenc[ed]" by a "set of indices" and "selected portions" are "schedule[d]" for "transmission" (such as by satellite or cable) and are in fact "transmitted," and ultimately each subscriber's device "download[s]" the particular information that it has requested. ('505 Patent at 17:68-18:36, 21:34-68.) If, as is likely, DIRECTV is found on remand not liable to Finisar for infringing the method claims (whether because DIRECTV does not infringe those claims or because they are invalid for their lack of novelty or obviousness—the independent invalidity grounds at issue there), that non-liability conclusion would likely apply to any similar system claims still at issue. If so, any determination by this Court on the indefiniteness question presented would have no practical effect—whether or not the Court sustained the indefiniteness ruling, DIRECTV would not be liable for infringing the similar system claims at issue here. In these circumstances, discretionary review is inadvisable.

Second, the validity of all claims at issue here is currently being reexamined by the PTO. *See* 35 U.S.C. §§ 302, 303 (permitting reexamination by the PTO where there is a "substantial new question of patentability"). The reexamination is focused on independent invalidity grounds (the same grounds of lack of novelty and obviousness that are at issue in the remand proceedings). Moreover, the PTO's conclusion thus far is that the claims are not

patentable because they lack novelty and are obvious. *See* Office Action in Ex Parte Reexamination, Nos. 90/008,282, 90/008,408, & 90/008,807 (Feb. 19, 2008). Should the PTO's conclusion of invalidity stand through the completion of the reexamination process, the claims will cease to exist, *see* 35 U.S.C. § 307(a), and that would make this Court's work nugatory. The Court should refrain from entertaining such a petition.

CONCLUSION

The petition should be denied.

Respectfully submitted,

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